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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,852

10/21/2003

Christopher Stevens

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EXAMINER

LEIVA, FRANK M

ART UNIT

PAPER NUMBER

3717

NOTIFICATION DATE

DELIVERY MODE

11/02/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mhmpto@mcandrews-ip.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,852	<b>Applicant(s)</b> STEVENS ET AL.	
	<b>Examiner</b> FRANK M. LEIVA	<b>Art Unit</b> 3717	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1-4,7,9-15,18,20 and 21 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-4,7,9-15,18,20 and 21 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Acknowledgements***

1. The examiner acknowledges claims 1, 9, 11, 12, 20 and 21 amended in applicant's submission filed 05 August 2011.

### ***Response to Arguments***

2. Applicant's arguments filed 05 August 2011 have been fully considered but they are not persuasive for the following reasons;
3. Regarding the argument on page 6 of applicant's remarks directed to the rejection of claims 1 and 12; "*Applicants respectfully submit that Seelig does not disclose a gaming machine that determines a probability of the successful subsequent outcome based on (1) the subsequent prize for the successful subsequent outcome and (2) the number of already won credits of the guaranteed first outcome. Rather, Seelig's subsequent binary outcome is merely randomly generated. See block 174 of Figure 9. Seelig's step 174, "generates and displays the either/or binary heads or tails outcomes." See paragraph [0050]. Thus, Seelig's probability of a successful outcome (heads or tails) is not based on (1) the amount of subsequent prize and (2) the number of credits already won.*" It is to be understood that the outcome in the present application is determined based on a weighted random selection is made to determined the size of the next prize. After the item has been determined the probability of success is determined (calculated). As admitted prior art it has been discussed that "probability" is a reflection or representation of what could happen and the math for it is known to be ruled by the game rules and payouts. Now, the outcome; that is the prize is determined based on the multiplier gained and the bonus previously awarded, and the probability of success is bound by the amount of monies wagered against the total prize monies and the number of possible chances for the outcome.
4. The examiner deems the argument not persuasive and the rejections proper.
5. Respectively dependent claims remain rejected for the same reasons set forth above with respect to claims 1 and 12.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1 and 12** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “a variable probability” is not described in the specification to enable one of ordinary skill in the art. Probability is a term used to describe an observation of a possibility of outcomes and once the rules for generating the outcome are set the probability of that outcome does not change.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**9. Claims 1-4, 7, 9-15, 18 and 20-21 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Seelig et al. (US 2002/0107066 A1).**

**10. Regarding claims 1 and 12; Seelig** discloses a gaming machine comprising a display, (fig. 1); and

a game controller

controlling images of symbols to be displayed on the display, (¶ [0045]);

effecting on the display a bonus feature wherein at least a first outcome is guaranteed to be a successful outcome resulting in credits, (fig. 5);

offering through the display a choice to select between continuing the bonus feature and ending the bonus feature,(fig. 9 #170) and,

if the choice selected is (a) continuing the bonus feature, determining (1) a subsequent prize for a successful subsequent outcome, (fig. 9 #172); and (2) a variable probability of the successful subsequent outcome based on the subsequent prize for the successful subsequent outcome and an amount of said credits, (¶ [0049], the subsequent outcome based on the bonus award already earned); and

generating a subsequent outcome utilizing the variable probability, (fig. 9 #170), if the subsequent outcome is a successful outcome, offering through the display the choice of continuing with the bonus feature, (fig. 9 #180);

but if the subsequent outcome is an unsuccessful outcome, (1) ending the bonus feature, (fig. 9 #186), and (2) forfeiting at least a portion of said amount of said credits, (fig. 9 #186).

**11. Regarding claims 2 and 13; Seelig** discloses wherein the game controller affects the bonus feature when a predetermined trigger condition occurs in a base game, (fig. 3 and 5).

**12. Regarding claims 3, 4, 14 and 15; Seelig** discloses wherein the display displays a pay table that indicates a number of credits that will be paid for various successful outcomes which occur during the playing of the bonus feature, and wherein the display

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includes a prize meter which provides a cumulative total of credits won due to successful outcomes which have occurred during the playing of the bonus feature (fig. 1), belly glass pay table and bonus meter 52 and 53 and total prize meter 54.

**13. Regarding claim 10;** Seelig discloses further comprising a selector receiving an input choice between continuing and ending the bonus feature, (¶ [0038]).

**14. Regarding claims 7 and 18;** Seelig discloses wherein the choice is continuing the bonus feature; the game controller determines the prize for a successful subsequent outcome using a weighted random selection, (claim 15).

**15. Regarding claims 9 and 20;** according to admitted prior art that all games of chance have and inherent probability and calculation of that probability is not dependent of an equation but on the rules of the game. Calculation of the probabilities involved in the game does not carry patentable weight.

Regarding the examiner's assertion of Official Notice; the examiner deems the Official Notice asserted in the previous action as admitted prior art since there was no contest or traverse raised in applicant's response to the action. Please see MPEP 2144.03.

**16. Regarding claim 11;** Seelig discloses if the subsequent outcome is an unsuccessful outcome forfeiting said amount of credits, (fig. 9 #186).

**17. Regarding claim 21;** Seelig discloses if the subsequent outcome is an unsuccessful outcome forfeiting said portion of said amount of credits, (fig. 9 #186; wherein a consolation prize inherently includes that all is not lost, that a portion still remains).

***Examiner's Note***

**18.** Admitted prior art statement from Office Action mailed 24 June 2009.

**19.** The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed .... "In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-F 11:00 am - 4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571) 272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/

Supervisory Patent Examiner, Art Unit 3717

/F. M. L./

Examiner, Art Unit 3717